

REMARKS

Applicants respectfully request entry of the Amendment and reconsideration of the claims. Please cancel claims 5-8, 13-15, and 17 without prejudice or disclaimer. Applicants reserve the right to pursue the cancelled subject matter in one or more continuation or divisional applications.

Election

Without acquiescing to the statements made therein, Applicants hereby elect Group I (claims 1-4 since claims 5-8 are herein cancelled) with traverse for prosecution in the instant application.

Traversal

Since this application is a national stage entry under 35 U.S.C. § 371 and as the Examiner notes, restriction of claims is to comply with the Unity of Invention standard under PCT Rules 13.1 and 13.2.

PCT Rule 13.1 states that "[t]he international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." MPEP § 1850. Further, PCT Rule 13.2 recites

[w]here a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Under MPEP § 1850(III)(A) the combination of an independent claim for a product and an independent claim for a use of said product constitutes one invention and does not merit restriction under PCT Rule 13 for Unity of Invention.

The method for determining unity of invention under PCT Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application: (A) In addition to an independent claim for a given product, an

independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of said product; or...

Therefore, a product claim and a process of preparing said product do not constitute separable inventions. Applicants have amended the claims so both the product claims and the process claims only recite polymorph IV of tiagabine hydrochloride. Applicants respectfully assert that the instant Group II claims (now claims 9-12 and 16 following amendment, which only recite polymorph IV of tiagabine hydrochloride) should be rejoined and examined in the same application.

The Examiner asserts that the claims of Groups I and II lack unity because the subject matter of Groups I and II is the compound of tiagabine hydrochloride, which was taught in the prior art. In view of the claims following cancellation of claims 5-8, 13-15, and 17, Applicants assert that the single general inventive concept is polymorph IV of tiagabine hydrochloride. The Examiner has not demonstrated polymorph IV of tiagabine hydrochloride in the prior art. Thereby, Applicants respectfully request that claims 9-12 and 16 of Group II be rejoined as having the same technical feature.

Election of Species

Applicants respectfully assert that an election of species is not necessary. However to comply with the office action of June 2, 2008, Applicants elect the species of polymorph IV of tiagabine hydrochloride for claims 1-4, 9-12, and 16.

The Examiner asserts at paragraphs 4-6 at page 3 that the application contains Markush claims directed to more than one species. Applicants respectfully traverse since:

1. the claims have been limited to polymorph IV of tiagabine hydrochloride in the instant amendment; and
2. there are no Markush claims in the application directed to more than one species.

As stated in MPEP 2173.05(h):

One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

None of the claims, instant or originally filed, recite the Markush language of “selected from the group consisting of...” Additionally, none of the claims, instant or originally filed, recite alternate species in the form “A, B, and C.” Therefore, there are no species in a Markush grouping to elect. In view of the foregoing, Applicants respectfully assert that the election of species is moot.

Summary

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300



Date: July 2, 2008

23552

PATENT TRADEMARK OFFICE

Brian R. Dorn, Ph.D.
Reg. No. 57,395

BRD:MTS:sab